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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,368	05/18/2007	Bjorn Bunte	P2520US00	8126
11764	7590	06/10/2011	EXAMINER	
Ditthavong Mori & Steiner, P.C. 918 Prince Street Alexandria, VA 22314			DOAN, TRANG T	
			ART UNIT	PAPER NUMBER
			2431	
			NOTIFICATION DATE	DELIVERY MODE
			06/10/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary	Application No. 10/591,368	Applicant(s) BUNTE ET AL.	
	Examiner TRANG DOAN	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89-97,99-124 and 127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89-91,94-97,99-109, 112-119, 122-124 and 127 is/are rejected.
- 7) ☒ Claim(s) 92,93,110,111,120 and 121 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 03/09/2011.
2. Claims 89, 92-93, 107, 110-111, 117 and 120-121 have been amended.
3. Claims 89-97, 99-124 and 127 are pending for consideration.

Response to Arguments

4. Applicant's arguments with respect to the rejection under 35 U.S.C. 112 first and second paragraph are persuasive. Therefore, the rejection under 35 U.S.C. 112 first and second paragraph has been withdrawn.
5. Applicant's arguments with respect to claims 89-97, 99-124 and 127 have been considered but are moot in view of the new ground(s) of rejection.

Specification

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b) (4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 89-97 and 99-106 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a process to be statutory

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under 35 USC 101 it must be tied to another statutory class or it transforms underlying subject matter to a different state or thing. In the instant application, claim 89 recites a method for determining to download a game application from a server to a mobile device. Claim 89 is neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter by imposing meaningful limits or significant steps properly tied to a particular machine, and therefore does not qualify as a statutory process. Any other claims not addressed are rejected by virtue of their dependency.

Allowable Subject Matter

8. Claims 92-93, 110-111 and 120-121 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 89-90, 94-96, 99-108, 112-118, 122-124 and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (US7286502) (hereinafter Rao) in view of Hoehne et al. (US20050181875) (hereinafter Hoehne).

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11. Regarding claim 89, Rao discloses a method comprising: determining to establish a wireless communication connection between a mobile terminal and a server stored with data (Rao: see figure 6; column 5 lines 49-66: a wireless device, CT/MD 602 with I/O ports 610 and CT/MD 612 with the ability to interface through a cradle adapter 604 having both wireless and wired connections 606; and column 6 lines 23-33); determining to establish a data network connection between the mobile terminal and the server, the data network connection being independent from the wireless communication connection (Rao: column 6 lines 4-12 and column 4 lines 15-31: dual T/R unit allows the internal processor to independently process the two incoming signal streams separately and optimally); determining to receive the data streams from the server to the mobile terminal via the data network connection and the wireless communication connection (Rao: column 4 lines 24-31 and column 6 lines 54-67).

Rao does not disclose the data stored at the server is a game application; determining to store the downloaded game application into an interchangeable mass storage, and determining to use the interchangeable mass storage in conjunction with different mobile terminals thereby enforcing digital right associated with the gaming application. However, Hoehne discloses the data stored at the server is a game application (Hoehne: paragraphs 0078); determining to store the downloaded game application into an interchangeable mass storage (Hoehne: paragraphs 0079 and 0090-0092), and determining to use the interchangeable mass storage in conjunction with different mobile terminals thereby enforcing digital right associated with the gaming application (Hoehne: paragraphs 0029, 0079 and 0090-0092). Therefore, it would have

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been obvious to a person skilled in the art at the time the invention was made to have included in Rao the feature of Hoehne as discussed above to provide a secured, subscriber information and phone books that can be moved from one mobile appliance to another (Hoehne: paragraph 0029).

12. Regarding claim 107, Claim 107 is an apparatus claim that is substantially equivalent to method claim 1. Therefore, claim 107 is rejected by a similar rationale.

13. Regarding claim 117, Claim 117 is a non-transitory computer-readable storage medium claim that is substantially equivalent to method claim 1. Therefore, claim 117 is rejected by a similar rationale.

14. Regarding claim 90, 108, 118 and 127, Rao as modified by Hoehne discloses wherein the gaming application is downloaded simultaneously using the wireless communication connection and the data network connection (Rao: column 6 lines 23-33).

15. Regarding claim 94, 112 and 122, Rao as modified by Hoehne discloses wherein the server permits downloading of the gaming application to only the mobile terminal (Rao: column 5 lines 19-23).

16. Regarding claim 95, 113 and 123, Rao as modified by Hoehne discloses wherein the wireless communication connection is established over a public land mobile network that performs at least one of authentication, authorization and payment procedures (Hoehne: paragraphs 0028 and 0030).

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17. Regarding claim 96, 114 and 124, Rao as modified by Hoehne discloses wherein the wireless communication connection is initiated by the mobile terminal or the server (Rao: see figure 7).

18. Regarding claim 99 and 115, Rao as modified by Hoehne discloses wherein the data network connection includes at least a local connection between an apparatus and the mobile terminal, and a sub-data network connection between the apparatus and the server, and the apparatus adapts the mobile terminal to the sub-data network connection (Rao: see figure 6).

19. Regarding claim 100 and 116, Rao as modified by Hoehne discloses wherein the sub-data network connection includes at least one of an analog telephone line connection, a digital telephone line connection, a broadband cable connection, a powerline communication connection, a glass fiber connection, a satellite downlink, an Ultrawideband connection, and a line of sight transmission connection (Rao: column 4 lines 45-48).

20. Regarding claim 101, Rao as modified by Hoehne discloses wherein the local connection between the mobile terminal and the apparatus is established by the mobile terminal (Rao: see figure 7).

21. Regarding claim 102, Rao as modified by Hoehne discloses wherein the sub-data network connection between the apparatus and the server is initiated by the mobile terminal (Rao: see figure 6: the cradle).

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22. Regarding claim 103, Rao as modified by Hoehne discloses wherein the local connection between the mobile terminal and the apparatus is established via a short-range wireless communication connection (Rao: column 5 lines 15-17).

23. Regarding claim 104, Rao as modified by Hoehne discloses wherein the apparatus is built in the mobile terminal (Rao: see figure 6).

24. Regarding claim 105, Rao as modified by Hoehne discloses wherein the settings of the apparatus are controlled by the mobile terminal or the server (Rao: column 5 lines 48-67).

25. Regarding claim 106, Rao as modified by Hoehne discloses wherein the settings include at least one of an address, a upload data rate, a download data rate, a packet size, a repeat rate, fragmentation, coding, and scrambling (Rao: column 3 lines 10-25).

26. Claims 91, 109, and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao in view of Hoehne, and further in view of Zhang (US7239864) (hereinafter Zhang).

27. Regarding claim 91, 109, and 119, Rao in view of Hoehne does not disclose further comprising: authenticating the mobile terminal via the wireless communication connection while downloading the gaming application via the data network connection. However, Zhang discloses authenticating the mobile terminal via the wireless communication connection while downloading the gaming application via the data network connection (Zhang: column 5 lines 3-11). Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to have

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included in Rao in view of Hoehne the feature of Zhang as discussed above to save one round trip of communication time (Zhang: column 5 lines 3-4).

28. Claim 97 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rao in view of Hoehne, and further in view of Thielke et al. (US6324564) (hereinafter Thielke).

29. Regarding claim 97, Rao in view of Hoehne does not disclose initiating by the server a call back function. However, Thielke discloses initiating by the server a call back function (Thielke: column 5 lines 1-20). Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to have included in Rao in view of Hoehne the feature of Thielke as discussed above to improve the efficacy of IP-based applications when running over wireless or other mobile networks (Thielke: column 2 lines 49-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRANG DOAN whose telephone number is (571)272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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